

BEFORE THE BOARD OF APPEALS AND INTERFERENCES
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED
AF
DEC 28 2001
TECH CENTER 1600/2900

In re application of: Ngai et al.

Group Art Unit: 1655

Serial No. 09/597,608

Examiner: Taylor, J.

Filed: June 20, 2000

Attorney Docket No.B00-100-1

For: *Normalizing and Amplifying RNA*

CERTIFICATE OF MAILING

I hereby certify that this corr is being deposited with the US Postal Service as First Class Mail in an envelope addressed to the Comm of Patents, Washington, D.C. 20231 on October 15, 2001

Signed

Richard Osman

REPLY BRIEF ON APPEAL

The Honorable Board of Appeals and Interferences
United States Patent and Trademark Office
Washington, D.C. 20231

Dear Honorable Board:

We rely on our Appeal Brief of record, and reply only to address several inaccurate statements made in the Answer.

First, the Answer's statement that "the rejections of claims 19 and 20 stand or fall together" is meaningless. Rejections do not stand or fall together: it is claims that are subject to a common rejection that can stand or fall together, or separately, at Appellant's discretion. Here, claims 19 and 20 are subject to different rejections under different statutes, so the claims do not stand or fall together.

Second, the Answer attempts to characterize the subject claim limitation as merely "an intent to use". This is untrue. There is no intent to use limitation at issue and the Answer's repeated attempt to characterize the issue as such misrepresents the record.

Third, the Answer persists in alleging that the written instructions recited in the claims of innumerable issued US Patents are not imparting patentability, and in particular, that the recited

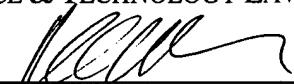
SEQ ID NOS of US 6,177,407 are imparting patentability. This is not true, and we refer the Board to footnote 2 of our Appeal brief, which the Answer appears to ignore.

Finally, we believe the present rejections are premised on a fundamental misunderstanding of the law. Instructions (i.e. algorithms) can provide not only a proper claim limitation, they can impart patentability even in the absence of the recitation of other structure. We request that the Examiner and/or Supervisor consult with Steven Kunin, who has substantial experience with this legal issue, before forwarding this appeal to the Board.

Appellants respectfully request reversal of the pending Final Action by the Board of Appeals.

Appellants hereby petition for any necessary extension of time pursuant to 37 CFR 1.136(a). The Commissioner is hereby authorized to charge any necessary fees associated with this communication to our Deposit Account No. 19-0750 (order no. B00-100-1).

Respectfully submitted,
SCIENCE & TECHNOLOGY LAW GROUP


Richard Aron Osman, Ph.D., #36,627
Tel(650)343-4341; Fax(650) 343-4342